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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,528	12/18/2000	Rabindranath Dutta	AUS920000919US1	2040
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Greg Goshorn, P.C. 9600 Escarpment Suite 745-9 AUSTIN, TX 78749			EXAMINER DENNISON, JERRY B	
			ART UNIT	PAPER NUMBER
			2143	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/740,528	<b>Applicant(s)</b> DUTTA, RABINDRANATH	
	<b>Examiner</b> JERRY B. DENNISON	<b>Art Unit</b> 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 3/3/2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-14 and 16-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-14 and 16-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **RESPONSE TO AMENDMENT**

1. This Action is in response to the Amendment of Application Number 09/740,528 received on 3/3/2008.
2. Claims 1-3, 5-14, and 16-21 are presented for examination.

### ***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claim 20 includes the limitation, "further comprising instructions for recording in the transcript at least one video image of the student recorded at a time other than during the exam to compare with the at least one video frame transmitted during the exam". Claim 21 includes the limitation, "further comprising storing within the transcript at least one video image of the student recorded at a time other than during the exam to compare with the at least one video frame transmitted during the exam". Applicant's specification does not provide the detail to show that applicant has invented this subject matter as claimed. The claims must be corrected to adequately describe the invention from the specification. See section 4, below, for more detail.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 20 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 20 includes the limitation, "further comprising instructions for recording in the transcript at least one video image of the student recorded at a time other than during the exam to compare with the at least one video frame transmitted during the exam". Claim 21 includes the limitation, "further comprising storing within the transcript at least one video image of the student recorded at a time other than during the exam to compare with the at least one video frame transmitted during the exam".

Applicant's specification does not provide the detail to show that applicant has invented this subject matter as claimed. Applicant's specification refers to Figure 9A, which includes a GUI displaying a student's transcript. Applicant's specification states, "There also is an image of the student 910 for verification of the student's identification if necessary" [see Applicant's specification, page 18, last paragraph]. The specification does not provide any evidence regarding when this image has been taken. The specification also does not provide any evidence that shows this picture is used for comparison. Since Applicant's specification only provides evidence of taking the student's picture at the time of the exam (see Applicant's specification, page 19), Examiner has reason to believe that this image 910 may be taken at the time of the exam as well. There is no comparison to another picture.

"[T]he essential goal' of the description of the invention requirement is to clearly convey the information that an applicant has invented the subject matter which is claimed." In re Barker, 559 F.2d 588, 592 n.4, 194 USPQ 470, 473 n.4 (CCPA 1977).

The written description requirement implements the principle that a patent must describe the technology that is sought to be patented; the requirement serves both to satisfy the inventor's obligation to disclose the technologic knowledge upon which the patent is based, and to demonstrate that the patentee was in possession of the invention that is claimed." Capon v. Eshhar, 418 F.3d 1349, 1357, 76 USPQ2d 1078, 1084 (Fed. Cir. 2005). Further, the written description requirement promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 5-14, 16-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoehn-Saric et al. (US 5,915,973).

Art Unit: 2154

6. Regarding claims 1, 8, and 14, Hoehn-Saric disclosed a method for administering exam content from a server to at least one client over a network, the method comprising:

registering at least one exam submitted by an exam provider with the server (Hoehn-Saric, col. 3, lines 1-15);

transmitting a video frame of a student to the server at least once during the exam to verify the identity of the student (Hoehn-Saric, col. 2, lines 60-65; col. 5, lines 40-50; col. 6, lines 45-53);

generating a transcript in response to answers submitted by the student to at least one exam question resident on the server (Hoehn-Saric, col. 7, lines 12-23);

storing the video frame in conjunction with the transcript (Hoehn-Saric, col. 7, lines 12-23; col. 9, lines 30-45); and

providing access to the transcript to at least one third party (Hoehn-Saric, col. 10, lines 5-10).

Claim 8 includes a system having a processor, memory, and a medium containing a program to implement the limitations of claim 1. Claim 14 includes a program product on a medium implementing the limitations of claim 1. Hoehn-Saric clearly disclosed a system or program as claimed (Hoehn-Saric, col. 3, lines 43-50).

7. Regarding claims 2, 10 and 16, Hoehn-Saric disclosed the limitations as described in claims 1, 8, and 14, including providing an exam content generator with

Art Unit: 2154

access to registered exams on the server, (Hoehn-Saric, col. 7, lines 13-17; col. 8, lines 51-60).

8. Regarding claims 3, 9, and 17, Hoehn-Saric disclosed the limitations, substantially as claimed, as described in claims 1, 8, and 14, including providing an exam grader with access to student's answers on the server, (Hoehn-Saric, col. 9, lines 30-45).

9. Regarding claims 5, 20, and 21, Hoehn-Saric disclosed the limitations, substantially as claimed, as described in claims 1, 8, and 14, including instructions for recording in the transcript at least one video image of the student recorded at a time other than during the exam to compare with the at least one video frame transmitted during the exam (Hoehn-Saric, col. 3, lines 1-8, Hoehn-Saric disclosed separate registration that includes obtaining biometric data form the test taker; col. 6, line 66 through col. 7, line 7; Biometric data includes a still image; col. 3, lines 20-25, comparing; see also col. 8, lines 29-35 and 47-50)

10. Regarding claims 6, 12, and 18, Hoehn-Saric disclosed the limitations, substantially as claimed, as described in claims 1, 8, and 14, including registering a plurality of exams with the server (Hoehn-Saric, col. 7, lines 35-45).

11. Regarding claims 7, 13 and 19, Hoehn-Saric disclosed the limitations, substantially as claimed, as described in claims 1, 8, and 14, including recording a student's answers to at least one exam question presented by the server; and grading the student's answers to generate an exam result, (Hoehn-Saric, col. 9, lines 35-45).

12. Regarding claim 11, Hoehn-Saric disclosed the limitations, substantially as claimed, as described in claims 1, 8, and 14, including wherein the server comprises a means for accepting and storing video images of the student (Hoehn-Saric, col. 6, lines 45-65).

### ***Response to Arguments***

Applicant's arguments, see Appeal Brief, filed 3/3/2008, with respect to the rejection(s) of claim(s) 1-3, 5-14, 16-21 under DiNicola and Sonnenfield have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is provided above.

It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims



with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

### ***Conclusion***

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 2154

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/J. B. D./  
Examiner, Art Unit 2143

/Nathan J. Flynn/  
Supervisory Patent Examiner, Art Unit 2154